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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,429	01/15/2002	Eliyahou Harari	M-10214-7C US	6805
36257	7590	04/22/2005	EXAMINER	
PARSONS HSUE & DE RUNTZ LLP 655 MONTGOMERY STREET SUITE 1800 SAN FRANCISCO, CA 94111			HUYNH, KIM NGOC	
			ART UNIT	PAPER NUMBER
			2182	

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary	Application No. 10/050,429	Applicant(s) HARARI ET AL.	
	Examiner Kim Huynh	Art Unit 2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-82 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

8

DETAILED ACTION

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 50-63 and 66-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Walters (US 5,357,573).

a. Claims 50, 59-63, 66, 67, and 71 Walter discloses a system for encoding/decoding the application program (user data) using a protection and comparison code/routine (useful information for encoding/decoding process) wherein the data and the information are both stored in different portions of a non-volatile memory 2 being a flash chip or EEPROM (col. 3, ll. 59-68) wherein the memory card having a controller 6 for controlling the read/write of the memory and a connector 8 for connecting to host memory for the transmitting of the data. Walters discloses the encoded user data stored in the first portion (modified application program) and a data information useful to the decode of the encoded user data stored in the second portion (protection code and protection routine, see claim 8, col. 6, ll. 41-52, see Fig. 2-4 and col. 3, ll. 59-65 for the first and second portion of the memory).

As for the recitation of the mother card and the first and second host, please note the memory card of Walter is connected to the first computer system hence the mother board) during the production and second host during usage of the memory. Since the memory card is connected to the computer, it is inherent that the card is connected to

the motherboard of the host. As for the mother card having a controller, this is an inherent features of computer's motherboard.

b. Claims 51-58, 68-70, 72-75, 76-78, 80-82, Walter discloses the user data is compressed/encoded user data (modified application program, claim 6, ll. 42-53) and the useful information being decompression/decryption algorithm/key (protection and comparison code/routine are algorithm/key for performing the decoding of the application program). Please also note, encrypt data is a form of compressed data.

Claims 50-64, 66-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe (US 5,093,731).

Watanabe discloses a memory card 1 for storing picture from a still camera, the memory card having a flash memory array 2 storing encoded data (images M) and information useful to the decoding of the data (see col. 3, ll. 10-47). The memory card having a connector for connecting to the camera and the first host being a still camera and the information is visual field data obtained the camera and the second host being a playback apparatus.

Wananabe discloses the memory card having a connector for connecting to the motherboard of the host device.

Claims 50-63, 66-70, 79-81 are rejected under 35 U.S.C. 102(b) as being anticipated by Austin (US 4,935,962, Mollier et al. (US 4,656,474), Ishording (US 4,816,651) or Viricel (US 5,343,530).

Austin Mollier, Ishording, and Vircel discloses various system having a volatile memory card system having for storing both encoded data and information useful for

Art Unit: 2182

the decoding of the encoded data being a key, algorithm for decompressed, decrypt the encoded data.

a. Austin discloses card 30 is removable connectable to/from the first and second host (recording and authenticating devices) via I/O interface 44/64 where in the memory is 42, data is M and information useful for the decoding of the encoded data (S, F, N, d, e) being secret key, public key and algorithm for decompressed, decrypt the encoded data (decompression is a form of decryption, col. 1, l. 63- col. 2, l. 8).

The card 30 is removable connectable to/from the first and second host (recording and authenticating devices) via I/O interface 44/64.

b. Molier discloses a system for storing on and retrieving user data M from a non-volatile memory card (transmitting device 1) comprising: encoding the user data M (col. 5, ll. 53-65), storing both the encoded user data and information useful to decode the encoded user data on the memory card 1 (col. 2, ll. 59-67), thereafter reading both the encoded user data and the decoding information from the memory card [signed message (M, I, SG) including signature and col. 6, ll. 36-37], and decoding the read encoded user data by use of the decoding information read from the memory card, thereby to obtain the user data (col. 7, l. 60 to col. 7, l. 43 and col. 8, ll. 16-23).

c. Ishording discloses a non-volatile memory card having flash EEPROM array MDC, encoded user data (INF) and information useful to the decoding of the encoded data (SK) on the first and second portion of the array (col. 2, ll. 45-66). The encoded user data includes encrypted user data and information includes decryption algorithm/key.

d. Similarly, Viricel discloses a system for storing both encoded data D and information useful to the decoding of the data in the EEPROM array 16; wherein the information useful to the decoding being a key K and encrypting algorithm C .

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 65 is rejected under 35 U.S.C. 103(a) as being obvious over Watanabe. Watanabe does not disclose the playback device being a personal computer. However, it is well known that memory cartridge of digital camera are utilized by computer for view images on the cartridge for use by personal computer for playing back the images. Therefore, it would have been obvious to one having ordinary skill in the art to utilize the cartridge by another digital camera or a PC for viewing purpose as a matter of preference which does not affect the function of the memory cartridge. This is no more than an intended use of the cartridge and does not result in a structural difference of the claimed invention.

Response to Arguments

Applicant's arguments filed 3/15/05 have been fully considered but they are not persuasive.

a. Applicant argues that the user data is not encoded, please note applicant defines the encoding/decoding function is simply compression/decompression.

encryption/decryption, key or algorithm for recovering the data stored within the memory card (p. 27, ll. 3-15). Walter discloses the application program is modified by the protection code and both are stored in the memory card. Watatnable discloses a compression/decompression algorithm for storing the image data and the image data stored in the memory card. Ishording and Mollier discloses storing data and the secret key in the memory card. Viricel and Austin discloses storing the algorithm for recovering the data both stored in the memory card. In each instances, the prior art reference reads on the “encoding” function of the claimed invention.

If applicant requires the encoded/decrypted data in a more specified format, the applicant is required to point out in the claim and specification the specific language in which applicant relies upon to overcome the rejection.

b. Applicant argues that the motherboard is not inherent in computer system.

The examiner respectfully disagrees with this argument. A motherboard is defined as the main circuit board of a microcomputer. The motherboard contains connectors for attaching additional boards, CPU, BIOS, memory, mass storage interface, serial and parallel ports and all the controllers required to control standard peripheral devices such as monitor, keyboard and disk drive. A definition of motherboard (pcwebopedia.com) and two articles from the PC GUIDE website titled “Motherboard and System Devices” and “Motherboard Integrated Components” are cited as extrinsic evidence and also to assist the applicant in the understanding of the basic concept and basic structure of motherboard in computer system.

As for the argument regarding motherboard, please in each instances, the prior art discloses the memory card is used in a computer environment and therefore a motherboard would undoubtedly be part of computer system.

Should applicant insist on arguing that the motherboard is not an inherent feature in computer system, applicant is required to prove that the computer systems used in the prior art do not require a motherboard. See MPEP 2112 [R.2] V.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

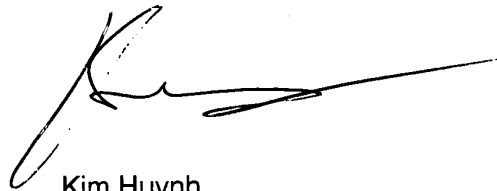
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2182

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Huynh whose telephone number is (571) 272-4147. Effective 10/20/04, the new telephone number is (571) 272-4147.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'Kim Huynh', with a long horizontal stroke extending to the right.

Kim Huynh
Primary Examiner
Art Unit 2182

KH
4/18/05